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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,323	09/18/2003	David J. Payne	08049.0933	6243
22852 7590 12/26/2007 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER JOSEPH, TONYA S	
			ART UNIT 3628	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/665,323	Applicant(s) PAYNE ET AL.	
	Examiner Tonya Joseph	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4-13, 16-25, 28-37 and 40-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-13, 16-25, 28-37 and 40-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Status of Claims

Claims 1, 4, 6-13, 16, 18-25, 28, 30-37, 40 and 42-48 have been amended. Claims 2-3, 14-15, 26-27 and 38-39 are cancelled. Claims 49-56 have been added. Thus, Claims 1, 4-13, 16-25, 28-37 and 40-56 are presented for Examination.

Response to Arguments

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Applicant implies, with respect to claim 1, that the term "incorrect address" is defined as an address which does not match information, in Applicant's specification. Examiner notes that the term "incorrect address" in the referenced section para. 49 describes an "incorrect address" **as comprising** a number of things including, but not limited to: "an un-coded address that includes a delivery address that does not match information in the ZIP+4 database due, for example, to bad delivery address information. An incorrect address record **may also comprise**, for example, an address without a ZIP+4 (or 9 digit) code." Applicant's specification provides no concrete definition of the term "incorrect address", thus, Examiner's interpretation will be consistent with the broadest reasonable interpretation of the word, "incorrect address", consistent with the specification.

Specification

1. The disclosure is objected to because of the following informalities: The amendment filed 10/18/2007 is objected to under 35 U.S.C. 132(a) because it

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introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. An example of some of the added material which is not supported by the original disclosure is as follows: all claims reciting and regarding a "second instance of the incorrect address", as recited in claim 1 and throughout the newly amended claims.

Applicant is required to cancel the new matter in the reply to this Office Action..

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 4-13, 16-25, 28-37 and 40-56 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. A "second instance of the incorrect address", as described in claim 1 and throughout several amended claims, is not described in Applicant's disclosure in any way. Therefore, Applicant has not shown that the claimed features were possessed at the time of invention resulting in the failure to meet the written description requirement..

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Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 4-13, 16-25, 28-37, 40-49, 51, 53 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen et al. U.S. Patent No. 5,422,821.

6. As per Claims 1, 25 and 37, Allen teaches receiving a first instance of an incorrect address to determine a correct address (see Col. 4 lines 23-28); resolving the first instance of the incorrect address by using at least one of a plurality of address resolution processes, storing a resolved address in a database (see Col. 8 lines 5-14 and Col. 2 lines 57-67); the resolved address comprising the correct address and the first instance of the incorrect address record (see Col. 7 lines 1-10 and Col. 2 lines 57-67);
comparing the incorrect address to the stored resolved address to determine that the incorrect address matches the stored first instance of the incorrect address (see Col. 15 lines 63-68 and Col. 16 lines 1-3)
and
outputting the correct address based on the determination (see Col. 9 lines 25-30).
Allen does not explicitly teach receiving a second instance of the incorrect address nor comparison of a *second instance* of the incorrect address, however, this is merely a re-checking step of an address record for a mail item that was previously corrected. It

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would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the system of Allen to include receiving a second instance of the incorrect address and performing a comparison in order to repeat the address correction process for any subsequent mail pieces addressed to the same receiver.

7. As per Claims 4, 28 and 40, Allen teaches the method and medium of claims 1 25 and 37 as described above. Allen further teaches wherein the incorrect address corresponds to an item being processed for delivery in an item delivery system (see Col. 2 lines 1-3). Allen does not explicitly teach receiving a second instance of the incorrect address, however, this is merely a re-checking step of an address record for a mail item that was previously corrected. It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the system of Allen to include receiving a second instance of the incorrect address and performing a comparison in order to repeat the address correction process for any subsequent mail pieces addressed to the same receiver.

8. As per Claims 5, 29 and 41, Allen teaches the method and medium of claims 4, 28 and 40 as described above. Allen further teaches wherein the item delivery system comprises the United States Postal Service (see Col. 5 lines 39-53). Although, Allen discloses a delivery system as set forth above; Examiner notes the recitation; wherein the item delivery system comprises the United States Postal Service constitutes intended use language and as such is afforded little patentable weight.

9. As per Claims 6, 30 and 42, Allen teaches the method and medium of claims 4 and 28 as described above. Allen further teaches wherein the item comprises at least

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one of a mailpiece (see Col. 8 lines 19-24). The recitation, “a United States Postal Service Priority Mail package, a United States Postal Service Express Mail Package, a United States Postal Service Global Express Mail Package, or a United States Postal Service Global Express Guarantee Package” is merely a statement of intended use and as such is afforded little patentable weight.

10. As per Claims 7, 31 and 43, Allen teaches the method and medium of claims 1 and 25 as described above. Allen further teaches wherein at least one of the plurality of address resolution processes includes sending an item including the first instance of the incorrect address, the item configured to be delivered in an item delivery system (see Col. 4 lines 41-55), to an element of the item delivery system that delivers in an area defined by a United States Postal Service ZIP code included in the first instance of the incorrect address (see Col. 4 lines 45-50) wherein the method further comprises at least one of verifying, validating or supplying information to be included in the correct address (see Col. 4 lines 56-58 and Col. 5 lines 1-10).

11. As per Claims 8, 32 and 44, Allen teaches the method and medium of claims 1 and 25 as described above. Allen further teaches wherein at least one of the plurality of address resolution processes includes entering first instance of the incorrect address into a database to obtain a correct United States Postal Service ZIP+4 code to be included in the correct address (see Col. 6 lines 54-68 and Col. 7 lines 1-4).

12. As per Claims 9, 33 and 45, Allen teaches the method and medium of claims 1 and 25 as described above. Allen further teaches wherein at least one of the plurality of address resolution processes includes modifying individual address components of the

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first instance of the incorrect address record to obtain a valid match to a database entry (see Col. 4 lines 62-68 and Col. 5 lines 1-4).

13. As per Claims 10, 34 and 46, Allen teaches the method and medium of claims 1 and 25 as described above. Allen further teaches wherein at least one of receiving and outputting further comprises utilizing at least one of regular mail, e-mail, facsimile, internet, or an interactive voice response system (see Col. 4 lines 23-40).

14. As per Claims 11, 35 and 47, Allen teaches the method and medium of claims 1 and 25 as described above. Allen further teaches wherein at least one of receiving and outputting further comprises communicating over a network (see Col. 4 lines 62-67, Examiner is interpreting a computer retrieval of information in a database as communication over a network).

15. As per Claims 12, 36 and 48, Allen teaches the method of claim 1 as described above. Allen further teaches wherein the incorrect address includes an incorrect United States Postal Service ZIP+4 code (see Col. 4 lines 23-26 and 30-36). Allen does not explicitly teach a second instance of the incorrect address nor comparison of a *second instance* of the incorrect address, however, this is merely a re-checking step of an address record for a mail item that was previously corrected. It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the system of Allen to include receiving a second instance of the incorrect address in order to repeat the address correction process for any subsequent mail pieces addressed to the same receiver.

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16. As per Claim 13, Allen teaches a first component for receiving a first instance of an incorrect address (see Col. 4 lines 23-28);
a second component for resolving the first instance of the incorrect address to determine a correct address by using at least one of a plurality of address resolution processes (see Col. 8 lines 5-14);
a third component for storing a resolved address in a database (see Col. 2 lines 57-67), the resolved address comprising the correct address and the first instance of the incorrect address (see Col. 7 lines 1-10 and Col. 2 lines 57-67).
a fourth component for outputting the correct address (see Col. 9 lines 25-30), wherein the first component receives an instance of the incorrect address (see Col. 4 lines 23-28) and requests that a component compare the instance of the incorrect address to the stored resolved address (see Col. 15 lines 63-68 and Col. 16 lines 1-3), wherein the component determines that the instance of the incorrect address matches the stored first instance of the incorrect address (see Col. 15 lines 63-68 and Col. 16 lines 1-3), and
wherein the fourth component outputs the correct address to the first component based on the determination (see Col. 9 lines 25-30). Allen does not explicitly teach a fifth component. Allen does teach the aforementioned steps as being **performed** by a fifth component. It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the system of Allen to include a fifth component because if it were considered desirable for any reason to separate the components of the system, it would be obvious to have separate components for that purpose. *In re*

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Dulberg, 289 F. 2d 522, 523, 129 USPQ 348, 349 (CCPA 1961). Allen does not explicitly teach receiving a second instance of the incorrect address nor comparison of a *second instance* of the incorrect address, however, this is merely a re-checking step of an address record for a mail item that was previously corrected. It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the system of Allen to further include receiving a second instance of the incorrect address and performing a comparison in order to repeat the address correction process for any subsequent mail pieces addressed to the same receiver.

17. As per Claim 16, Allen teaches the system of claim 13 as described above. Allen further teaches wherein the incorrect address corresponds to an item being processed for delivery in an item delivery system (see Col. 2 lines 1-3). Allen does not explicitly teach receiving a second instance of the incorrect address, however, this is merely a re-checking step of an address record for a mail item that was previously corrected. It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the system of Allen to include receiving a second instance of the incorrect address and performing a comparison in order to repeat the address correction process for any subsequent mail pieces addressed to the same receiver.

18. As per Claim 17, Allen teaches the system of claim 16 as described above. Allen further teaches wherein the item delivery system comprises the United States Postal Service (see Col. 5 lines 39-53). Although, Allen discloses a delivery system as set forth above; Examiner notes the recitation; wherein the item delivery system comprises

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the United States Postal Service constitutes intended use language and as such is afforded little patentable weight.

19. As per Claim 18, Allen teaches the system of claim 16 as described above. Allen further teaches wherein the item comprises at least one of a mailpiece (see Col. 8 lines 19-24). The recitation, "a United States Postal Service Priority Mail package, a United States Postal Service Express Mail Package, a United States Postal Service Global Express Mail Package, or a United States Postal Service Global Express Guarantee Package" is merely a statement of intended use and as such is afforded little patentable weight.

20. As per Claim 19, Allen teaches the system of claim 13 as described above. Allen further teaches wherein at least one of the plurality of address resolution processes includes sending an item including the first instance of the incorrect address, the item configured to be delivered in an item delivery system (see Col. 4 lines 41-55), to an element of the item delivery system that delivers in an area defined by a United States Postal Service ZIP code included in the first instance of the incorrect address (see Col. 4 lines 45-50) wherein the method further comprises at least one of verifying, validating or supplying information to be included in the correct address (see Col. 4 lines 56-58 and Col. 5 lines 1-10).

21. As per Claim 20, Allen teaches the system of claim 13 as described above. Allen further teaches wherein at least one of the plurality of address resolution processes includes entering first instance of the incorrect address into a database to obtain a

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correct United States Postal Service ZIP+4 code to be included in the correct address (see Col. 6 lines 54-68 and Col. 7 lines 1-4).

22. As per Claim 21, Allen teaches the system of claim 13 as described above. Allen further teaches wherein at least one of the plurality of address resolution processes includes modifying individual address components of the first instance of the incorrect address record to obtain a valid match to a database entry (see Col. 4 lines 62-68 and Col. 5 lines 1-4).

23. As per Claim 22, Allen teaches the system of claims 13 as described above. Allen further teaches wherein at least one of the first component or the fourth component are further configured for utilizing at least one of regular mail, e-mail, facsimile, internet, or an interactive voice response system (see Col. 4 lines 23-40).

24. As per Claim 23, Allen teaches the system of claim 13 as described above. Allen further teaches wherein at least one of the first component or fourth component are further configured for communicating over a network (see Col. 4 lines 62-67, Examiner is interpreting a computer retrieval of information in a database as communication over a network).

25. As per Claim 24, Allen teaches the system of claim 13 as described above. Allen further teaches wherein the unresolved address includes an incorrect United States Postal Service ZIP+4 code (see Col. 4 lines 23-26 and 30-36). Allen does not explicitly teach receiving a second instance of the incorrect address, however, this is merely a re-checking step of an address record for a mail item that was previously corrected. It would have been prima facie obvious to one of ordinary skill in the art at the time of

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invention to modify the system of Allen to include receiving a second instance of the incorrect address in order to repeat the address correction process for any subsequent mail pieces addressed to the same receiver.

26. As per Claim 49, Allen teaches the method of claim 1 as described above.

Although Allen does teach receiving a correct address (see Col. 4 lines 23-28), Allen does not explicitly teach receiving a second incorrect address, however, this is merely a repetitious step for another mail item that wasn't previously corrected and/or saved, which is the same as the "first instance" of an incorrect address of Claim 1. It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the system of Allen to include receiving a second instance of the incorrect address in order to repeat the address correction process for any subsequent mail pieces that were not yet corrected.

27. Claims 50, 52, 54 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen et al. U.S. Patent No. 5,422,821 in view of Cordery U.S. Patent No. 5,682,429.

28. As per Claims 50, 52, 54 and 56, Allen further teaches comparing the incorrect address to the stored resolved address; resolving the incorrect address (see Col. 15 lines 63-68 and Col. 16 lines 1-3) to determine a correct address using at least one of the plurality of address resolution processes (see Col. 4 lines 23-28); and storing the incorrect address and the correct address a part of a resolved address in the database (see Col. 8 lines 5-14; Col. 2 lines 57-67; Col. 7 lines 1-10 and Col. 2 lines 57-67); Allen does not explicitly teach the method taught by Cordery when the incorrect address does

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not match the stored first instance of the incorrect address (see Col. 11 lines 11-27). It would have been prima facie obvious to one of ordinary skill at the time of invention to modify the method of Allen to include the teachings of Cordery to determine if an address was previously corrected, as taught by Cordery Col. 11 lines 20-29. Allen does not explicitly teach comparing, resolving or storing a second incorrect address, however, this is merely a repetitious step for another mail item that wasn't previously corrected and/or saved, which is tantamount to the "first instance" of an incorrect address of Claim 1. It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the system of Allen to include receiving a second instance of the incorrect address in order to repeat the address correction process for any subsequent mail pieces that were not yet corrected. Although Allen discloses the steps of Applicant's invention, Allen does not explicitly teach specific components performing the steps, however, the mere execution of steps being performed by different components does not render the invention patentable over the prior art. It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the system of Allen to specific components performing the steps because a mere re-arrangement of parts does not distinguish itself from the prior art unless a new and unexpected result is found.

29. As per Claim 51, Allen teaches the system of claim 13 as described above. Allen further teaches wherein the first component receives an incorrect address (see Col. 4 lines 23-28). Allen does not explicitly teach receiving a second incorrect address, however, this is merely a repetitious step for another mail item that wasn't previously

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corrected and/or saved, which is the same as the "first instance" of an incorrect address of Claim 1. It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the system of Allen to include receiving a second instance of the incorrect address in order to repeat the address correction process for any subsequent mail pieces that were not yet corrected.

30. As per Claim 53, Allen teaches the medium of claim 25 as described above. Adam further teaches, wherein the instructions, when executed by a processor, further perform the stage of receiving of an incorrect address (see Col. 4 lines 23-28). Allen does not explicitly teach receiving a second incorrect address, however, this is merely a repetitious step for another mail item that wasn't previously corrected and/or saved, which is the same as the "first instance" of an incorrect address of Claim 1. It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the system of Allen to include receiving a second instance of the incorrect address in order to repeat the address correction process for any subsequent mail pieces that were not yet corrected.

31. As per Claim 55, Allen teaches the system of claim 37 as described above. Allen further teaches wherein the means for receiving receives an incorrect address (see Col. 4 lines 23-28). Allen does not explicitly teach receiving a second incorrect address, however, this is merely a repetitious step for another mail item that wasn't previously corrected and/or saved, which is the same as the "first instance" of an incorrect address of Claim 1. It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the system of Allen to include receiving a second

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instance of the incorrect address in order to repeat the address correction process for any subsequent mail pieces that were not yet corrected.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

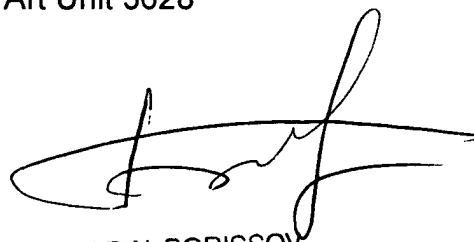
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tonya Joseph whose telephone number is 571-270-1361. The examiner can normally be reached on Mon-Fri 7:30am-5:00pm First Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571 272 0847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tonya Joseph
Examiner
Art Unit 3628



IGOR N. BORISSOV
PRIMARY EXAMINER